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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,129	09/08/2003	Fukushi Hirayama	02213.000300.1	8648

5514 7590 06/23/2006

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,129

Applicant(s)

HIRAYAMA ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/148,544.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 3-8 are pending in the application.

This action is in response to applicants' amendment dated April 10, 2006.

Claims 1 and 6 have been amended, claim 2 has been canceled and claim 8 is newly added.

Response to Arguments

Applicant's arguments filed April 10, 2006 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 1b), c), d) and e) of the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejection labeled a), the applicants' amendments and remarks have been fully considered but they are not found persuasive.

a) The applicant's stated that they have adopted all of the Examiner's suggestions and corrected the informalities in the amendment to claim 1. However, claims 3-7 have not been corrected with respect to "derivative".

Claims 3-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record.

2. The applicants amendments and arguments are sufficient to overcome the 35 U.S.C. § 102, anticipation rejection labeled paragraph 2) of the last office action, which is hereby **withdrawn**.

3. The applicants amendments and arguments are sufficient to overcome the 35 U.S.C. § 102, anticipation rejection labeled paragraph 3) of the last office action, which is hereby **withdrawn**.

4. The applicants amendments and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection labeled paragraph 4) of the last office action, which is hereby **withdrawn**.

5. The applicants amendments and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection labeled paragraph 5) of the last office action, which is hereby **withdrawn**.

6. With regards to the obviousness-type double patenting rejection as being unpatentable over U.S. 6,642,224 of the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 1 and 3-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,642,224.

7. With regards to the provisional obviousness-type double patenting rejection as being unpatentable over copending Application No. 10/399,625 of the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 1 and 3-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/399,625.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In view of the amendment dated April 10, 2006, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 5 is vague and indefinite in that it is not known what is meant by the nomenclature of the 3rd species, which is missing a close “)” and an open “(“.
- b) Claim 5 is vague and indefinite in that it is not known what is meant by the nomenclature of the 4th species, which is missing a close “)” and an open “(“.
- c) Claim 5 is vague and indefinite in that it is not known what is meant by the nomenclature of the 5th species where the species is 5-bromo-N-(5-chloro-2-pyridyl)-3-hydroxy-2-t[4-(4-methyl-1,4-diazepan-1-yl)benzoyl]amino}benzamide.
- d) Claim 5 is vague and indefinite in that it is not known what is meant by the nomenclature of the 5th species, which is missing an open “{”.

- e) Claim 8 is vague and indefinite in that it is not known what is meant by the list of species where it is not known if these are compounds selected from the group or compositions or the method of use.
- f) Claim 8 is vague and indefinite in that it is not known what is meant by diazapan in the nomenclature of the first seven species.
- g) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the 8th species, which includes 1,2-phenylenediaraine.
- h) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the 14th species, which is missing a close ")" and an open "[".
- i) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the 15th species, which is missing a close "]" and an open "(".
- j) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the 15th species, which includes 1,2-phenylenedianaine.
- k) Claim 8 recites the limitation "hydrogen sulfate" in the nomenclature of the 23rd species. There is insufficient antecedent basis for this limitation in the claim.
- l) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the 24th species, which includes 4-maethoxybenzoyl.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Brenda L. Coleman
Primary Examiner Art Unit 1624
June 21, 2006